

## REMARKS

In the Office Action mailed from the United States Patent and Trademark Office on October 19, 2004, the Examiner rejected claims 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Application No. 08217686 A (“JP ‘686”); and claims 1-28 and 31-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,039,559 (“the ‘559 patent”) in view of U.S. Patent Application No. 2002/0068102 (filed Dec. 1, 2000) (“the ‘102 application”). Accordingly, Applicant respectfully provides the following:

### Rejections under 35 U.S.C. § 103

An invention is unpatentable under Section 103(a) “if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.” To establish a *prima facie* case of obviousness, three criteria must be met.

First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP § 2142.

JP ‘686 does not teach or suggest all of the claim limitations present in claims 29 and 30. JP ‘686 teaches using a product extracted, with organic solvents, from dried roots of *Morinda citrifolia* to eradicate *heliobacter pylori*. Claim 27 of the present invention from which claims 29 and 30 depend has been amended to claim, “[a] method for inhibiting cancerous growth ... comprising the steps of: administering, to a patient, at least two ounces of a formulation comprising: processed *Morinda citrifolia* juice; and processed *Morinda citrifolia* puree twice

daily, wherein said composition blocks DNA adduct formation, scavenges free radicals, quenches lipid hydroperoxides and selectively inhibits COX-2.” JP ‘686 does not teach using *Morinda citrifolia* juice. JP ‘686 does not teach using *Morinda citrifolia* juice with *Morinda citrifolia* puree. Extract from dried roots is not juice combined with puree. Further, JP ‘686 teaches a method of eradicating *heliobacter pylori*. There is no suggestion in JP ‘686 to use *Morinda citrifolia* to inhibit cancerous growth. Because JP ‘686 does not teach all of the elements claimed in the present invention, Applicant respectfully submits that the proposed claims are neither anticipated nor rendered obvious by JP ‘686.

Claims 1-28 and 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,039,559 (“the ‘559 patent”) and U.S. Application No. 2002/0068102 (filed Dec. 1, 2000) (“the ‘102 application”). The invention entity for the present application and the ‘102 application are the same. Stephen P. Story’s name was unintentionally, and without deceptive intent, omitted from the present application. Attached is a copy of the petition to have Stephen P. Story’s name added to the present application. Because the effective date of the present invention, December 31, 2001, is less than one year from the earliest priority date for the ‘102 application, November 29, 2001, the ‘102 application is not prior art that can be cited against the present application.

The ‘559 patent alone does not teach or suggest all of the claim limitations of claims 1-28 and 31-33. The ‘559 patent teaches aliphatic carboxylic acid esters of Vitamin E which exhibit the biological activities of Vitamin E. The ‘559 application suggests that physiological damage resulting from the administration of carbon tetrachloride to animal is thought to be due to free radicals. The claims of the current application have been amended to include elements not present in the prior art cited. Specifically, the present invention claims a method comprising

“administering, to a patient, at least two ounces of a formulation comprising: processed *Morinda citrifolia* juice; and processed *Morinda citrifolia* puree twice daily, wherein said composition blocks DNA adduct formation, scavenges free radicals, quenches lipid hydroperoxides and selectively inhibits COX-2.” The ‘559 application does not suggest utilizing the claimed formulation of *Morinda citrifolia*. Because the ‘102 application is a product of the same inventive entity as the present application, and because the ‘559 patent does not teach all of the elements claimed in the present invention, Applicant respectfully submits that the proposed claims are neither anticipated nor rendered obvious by the ‘559 patent and the ‘102 application.


### CONCLUSION

Based on the foregoing, Applicant respectfully submits that the deficiencies in the application have been corrected and that the proposed claims are neither anticipated nor rendered obvious by the prior art reference cited by the Examiner. As such, Applicant believes that the claims are now in a condition for allowance, and action to that end is respectfully requested.

If any impediments to the allowance of this application for patent remain after the above amendments and remarks are entered, the Examiner is invited to initiate a telephone conference with the undersigned attorney of record.

DATED this 12 day of November, 2004.

Respectfully submitted,



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